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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/112,276	07/09/1998	TSE HO KEUNG		6721

7590 06/17/2003

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EXAMINER

BARRON JR, GILBERTO

ART UNIT

PAPER NUMBER

2132

DATE MAILED: 06/17/2003 47

Please find below and/or attached an Office communication concerning this application or proceeding.

7B

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/112,276	HO KEUNG, TSE	
	Examiner	Art Unit	
	Gilberto Barrón Jr.	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 19 February 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-22 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-22 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. 08/578,448.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ .

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_ .

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

***Allowable Subject Matter***

1. Claims 1-22 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.
2. Claims 1-22 are allowed over the prior art of record.
3. Applicant's arguments in the Appeal Brief filed February 19, 2003 are persuasive in overcoming the various rejections based on the Wiedemer and Haas references.
4. In particular the arguments that the Haas reference does not show the claimed limitations of " said identity/information, if so existing, being capable of being used in enabling electronic commerce operation(s) for which rightful user(s) of said software desired to be protected has to be responsible;

access to said software desired to be protected is being provided without causing a said operation being performed and said identity means/information being specific to said rightful user(s) and said software desired to be protected being licensed to said rightful user(s)." are persuasive in overcoming the rejections base on Widener and Haas references.

***Claim Rejections - 35 USC § 112***

5. Claims 1, 9, 11 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite for the term "means/information". The use of the term "means" invokes the 6<sup>th</sup> paragraph of section 35 USC 112. This requires the interpretation of "means" to correspond to what is disclosed in the specification. The use

of "means/information" does not allow determination of what is disclosed in the specification, e.g., is it information or a software module.

Applicant's arguments regarding the use of means/information should be supplemented with a showing of where support for this element is found in the specification. If, Applicant can make such a showing then this rejection may be overcome.

Claim 1, is indefinite as "favourable" is a relative term and it is not clear to whom would apply "favourable". It is suggested to use terms that are present in the specification that correspond to this step. Another suggestion would be to use "positive determination"

Claims 9 and 11 are indefinite because the claim a "carrier wave". A carrier wave is not a physical thing, as such it cannot be claimed.

Applicant is directed to the language used below to express that the computer readable medium interacts with a computer to cause it to execute the claimed method.

Claim 22 is indefinite because it seeks to patent a program per se. A program per se is a data structure and not a physical thing. Applicant should redraft these claims to recite "A computer readable medium having program code for causing a computer to execute the method steps of claims \_\_\_\_".

***Double Patenting***

6. Applicant should also resolve the matter of conflicting applications.
7. Claims 1-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of co-

pending Application No. 08/587,448. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-22 of this application are broader than claims 1-15 of the parent application. The subject matter of application claims 1-22 is obvious from the subject matter of co-pending parent claims 1-15, i.e. there does not appear to be any substantial difference between the claims in the parent application and this application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Applicant is advised that abandonment of the parent application is not required, but would obviate this double patenting rejection and would not require relinquishing the priority date established by the parent. A terminal disclaimer in this application would also obviate this double patenting rejection and does not require abandonment or relinquishing priority date. In either case, withdrawal of priority date is not required.

#### *Drawings*

9. The specification on page 3, provides a Brief Description of the Drawings, Figures 1 and 2. However, there were no sheets of drawings in the application papers filed July 9, 1998. If Applicant intends to submit such Figures now, Applicant is required to show that 1) NO NEW MATTER is being entered, and 2) the figures are the same as those provided for in the specification as filed. Applicant may simply state that the Figures are the same as those of the parent application, if such is the case, in order to meet the "no new matter" requirement

10. Applicant is requested to submit these figures in response to this action.

**11. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gilberto Barrón Jr. whose telephone number is (703) 305-1830. The examiner can normally be reached on Mondays thru Thursdays from 8:00 AM to 5:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, Mr. Albert Decady, can be reached on (703) 305-9595, may be contacted for further assistance.

The fax phone number for OFFICIAL responses for the organization where this application or proceeding is assigned is (703) 746-7239.

The fax phone number for AFTER FINAL responses for the organization where this application or proceeding is assigned is (703) 746-7238.

The fax phone number for DRAFT proposals for the organization where this application or proceeding is assigned is (703) 746-7240

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

*Gilberto B.*  
GILBERTO BARRON  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100